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### **REMARKS**

Applicants submit the instant Response to the non-final Office Action mailed 25 January 2005 in which claims 1-7 and 15-21 were indicated as withdrawn from consideration and pending claims 8-14 and 22-27 were rejected.

Herein applicants cancel claims 1-7 and 22-27 without prejudice or disclaimer as to the subject matter thereof, amend claims 8, 9, 12, 13, 15, 19, 22, and 26, and add no new claims. Applicants note that the body of the Office Action (at page 2) apparently inadvertently indicated that "[c]laims 1-8 are withdrawn contrary to the Office Action Summary (and the prior restriction requirement) wherein claims 1-7 are indicated as withdrawn. Applicants have therefore proceeded with the election as previously stated by formally cancelling claim 7 and continuing prosecution of claim 8.

Applicants respectfully request entry and favorable consideration of the amendments and remarks presented herewith.

#### **Rejection Under 35 U.S.C. §112**

Claims 8-14 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite due to the recitation of "the compressed data" in claim 8.

Applicants herewith amend claim 8 to address the rejection and respectfully suggest that the amendment cures the rejection as to claims 8-14 so that the ground of rejection should be withdrawn.

#### **Rejection Under 35 U.S.C. §103**

Claims 8-14 and 22-27 stand rejected under 35 U.S.C. §103(a) as being unpatentable of U.S. Pat. No. 5,479,922 to Riechl (Riechl).

Applicants amend the independent claims to distinguish the present invention over Riechl by, among other limitations, including automatically comparing or analyzing a filtered and compressed *intra-cardiac* electrogram

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(EGM) to reveal whether an event of *cardiac ischemia* is present and/or *storing or transmitting* a signal relating to the comparison or analysis.

Applicants suggest that Riechl neither discloses or depicts such methods or apparatus and as such cannot support a *prima facie* obviousness rejection and therefore the invention as presently claimed should properly proceed to timely issuance as U.S. Letters Patent.

In addition, in connection with combining references to support an assertion of obviousness, it is well established that the Examiner bears the burden of establishing a *prima facie* case of obviousness. In re Oetiker, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). In doing so, the Examiner must determine whether the prior art provides a "teaching or suggestion to one of ordinary skill in the art to make the changes that would produce" the claimed invention. In re Chu, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995). A *prima facie* case of obviousness is established only when this burden is met.

**The burden is still on the Examiner even when the Examiner relies upon a single reference.** "Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference." In re Kotzab, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

In the case of In re Lee, 61 USPQ2d 1430 (Fed. Cir. 2002), the Federal Circuit stated: "This factual question of motivation is material to patentability, and [can] not be resolved on subjective belief and unknown authority." *Id.* at 1434. Determination of patentability must be based on evidence, *id.* at 1434, and the Examiner provided none: no references pertaining to aggregation or averaging were cited, no official notice was taken, no evidence of any kind was presented. The Examiner's failure to present an evidentiary basis for the decision is clearly a legal error. *Id.* Assertions such as "common knowledge and common sense," even if assumed to derive from the Examiner's expertise, are not evidence, and conclusory statements do not fulfill the Examiner's obligation to make an

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evidentiary record. Id. at 1434-35; In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

If indeed the elements were known in the art, then the Examiner ought to present evidence to support that conclusion. In re Lee, 61 USPQ2d at 1435 ("[W]hen they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record."). The failure to do so renders the Examiner's rejection arbitrary, capricious and unreasonable. See id. at 1434. The Examiner may not arbitrarily, capriciously and unreasonably deny a claim by a mere declaration of obviousness without a supporting evidentiary record.

In the present Office Action the Examiner offers a wholesale rejection of claims 8-14 and 22-27 based on the single Riechl reference and Applicants respectfully suggest that Riechl alone fails to render the presently claimed invention obvious and respectfully requests reconsider of the grounds of rejection of the claims.

Applicants believe that the pending claims are now in condition for allowance and solicit a Notice of Allowance so that the claimed invention may pass to timely issuance as U.S. Letters Patent.

### CONCLUSION

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned attorney to attend to these matters.

Respectfully submitted,

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